

*REMARKS*

The Office Action and cited references have been reviewed. Claims 1-4 and 9-11 are rejected. Claims 5-8 and 12-16 have been withdrawn. Claims 1 and 2 have been amended. Support for the amendments is found generally within the application and specifically as noted below. Claims 17-28 have been cancelled. Claims 29-35 have been added and read upon the elected species, namely species III of FIG. 10. Consideration of the pending claims is respectfully requested.

*Objection to the Drawings*

The Office Action has objected to the drawings for various reasons. Paragraphs [0033], [0035], [0038], [0049], [0051], [0058], [0059], and [0060] have been amended to address each of the objections to the drawings. No new matter has been entered or added as these amendments are evident from the drawings and/or the specification. In light of the amendment to the specification, it is respectfully submitted that the objection to the drawings has been overcome and should be withdrawn.

*Objection to the Specification*

The Office Action has objected to the specification because reference number “742” is referring to a tacky, skid resistant surface and a removable adhesive and reference number “712” appears to be incorrect and should be “711.” Paragraphs [0049] and [0052] have been amended to address the objection to the specification. No new matter has been entered or added as these amendments are evident from the drawings and/or the specification. In light of the amendment to the specification, it is respectfully submitted that the objection has been overcome and should be withdrawn.

*Rejection under 35 U.S.C. §102*

The Office Action has rejected Claims 1, 2 and 11 under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. App. No. 4,239,099 to Williams et al. (hereinafter “Williams”). In response, independent claim 1 has been amended to more clearly distinguish Williams.

It is axiomatic in the patent law that to reject a claim under 35 U.S.C. §102, each and every limitation must be found, expressly or inherently, in a single reference and arranged as required by the claims such that the reference discloses the identical invention. *See* MPEP 2131. Anticipation is not established if, in reading a claim on something disclosed in a reference, it is necessary to pick, choose, and combine various portions of the disclosure not

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directly related to each other by the teachings of the reference. See Ex parte Beuther, 71 USPQ2d 1313 (BdPatApp&Int 2003), citing In re Arkley, 172 USPQ 524, 526 (CCPA 1972).

It is respectfully submitted that Williams does not disclose or suggest the invention claimed by independent claim 1 as amended and therefore cannot anticipate this claim because it fails to teach each and every limitation required by this claim as is required by 35 U.S.C. §102 and explained below.

As presently written, claim 1 recites, *inter alia*, a “reduced friction layer on the support surface directly supporting and contacting the merchandise.” In contrast, as collectively shown in FIGS. 4 and 5 of Williams, the strip of low friction material is covered by a conveyor belt. (See also Col. 3, lines 32-36, and Col. 4, lines 21-27). Therefore, the strip of low friction material of Williams does not directly support and contact the merchandise as recited in claim 1 of the present application. As such, claim 1 is not anticipated by Williams. It is respectfully submitted that the rejection of claim 1 be withdrawn.

Claims 2 and 11 depend from and include the limitations of claim 1 and are believed to be patentable for the reasons stated above for claim 1. Therefore, it is respectfully submitted that the rejection of claims 2 and 11 should be withdrawn.

Rejection under 35 U.S.C. §103

The Office Action has rejected claims 1-3 and 9-11 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,878,895 to Springs (hereinafter “Springs”) in view of U.S. Pat. No. 4,346,806 to Bustos (hereinafter “Bustos”). This ground of rejection is respectfully traversed. Reconsideration of the rejection in view of the following comments is respectfully solicited.

To establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one skilled in the art, to modify the reference or combine teachings. Any proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference. There must be a reasonable expectation of success and the prior art references must teach or suggest all of the claim limitations. See M.P.E.P. §2143. Conclusory statements cannot be relied on when dealing with particular combinations of prior art and specific claims. The rationale for combining references must be put forth. *In re Lee*,

61 U.S.P.Q.2d 1430, 1433. The Examiner can satisfy the burden of showing obviousness of the combination “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”.

As presently written, claim 1 recites, *inter alia*, a “reduced friction layer on the support surface directly supporting and contacting the merchandise.” The Office Action has only relied upon Bustos, and not Springs, for the teaching of an apparatus having a reduced friction layer. As shown in FIG. 2 of Bustos, the low friction tape is covered by a belt. (See also Col. 2, lines 35-51). As a result, the strip of low friction material cannot directly support and contact the merchandise as recited in claim 1 of the present application. Therefore, the combination of Bustos with Springs does not cure the deficiency of Springs to teach or suggest the reduced friction layer on the support surface directly supporting and contacting the merchandise. As such, claim 1 is believed to be patentable over Springs in view of Bustos and it is respectfully submitted that the rejection of claim 1 be withdrawn.

Claims 2-3 and 9-11 depend from and include the limitations of claim 1 and are believed to be patentable for the reasons stated above for claim 1. Therefore, it is respectfully requested that the rejection of claims 2-3 and 9-11 be withdrawn.

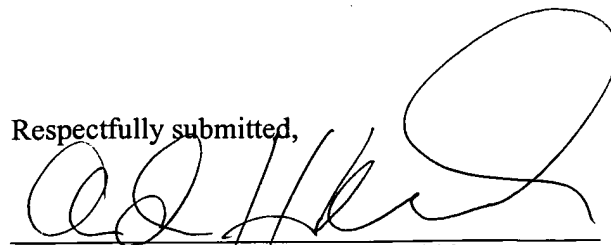
Claims 3-4 have been further been rejected under 35 U.S.C. §103(a) as being unpatentable over Williams or Williams in view of U.S. Pat. No. 6,218,017 to Yamashita et al. (hereinafter “Yamashita”). Neither the modification of Williams or the combination of Yamashita with Williams cures the deficiency of Williams failing to teach or suggest the “reduced friction layer on the support surface directly supporting and contacting the merchandise” as recited in claim 1. Therefore, the rejection of claims 3-4 is moot and should be removed.

#### *Conclusion*

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read 'A. J. Heinisch', written over a horizontal line.

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